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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/390,583      | 09/02/1999  | PER JUST ANDERSEN    | 11527.209           | 7141             |

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EXAMINER

ROCHE, LEANNA M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1771

DATE MAILED: 03/06/2002

27

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/390,583

Applicant(s)

ANDERSEN ET AL.

Examiner

Leanna Roche

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. The amendments filed on December 12, 2001 have been entered and carefully considered. However, it is noted that the amendments fail to comply with 37 CFR 1.173(b)(2) because the amended claims do not contain a parenthetical expression, "amended", "twice amended," etc.
2. Applicant's submission of a new declaration, a Statement under 37 CFR 3.73(b), and the Surrender of the Original Patent are sufficient to overcome the previous rejection to the Declaration, and the objections with regard to the Statement under 37 CFR 3.73(b) and Surrender of Original Patent set forth in Paper No. 24, paragraphs 3-7.

### ***Reissue Applications***

3. Claims 32-57 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. V. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

The newly amended claims do not contain the limitation that the fibrous material has an average fiber length of greater than about 2 mm. The newly amended claims contain the limitation that the fibrous material has a fiber length less than about 25 mm. Therefore, the newly amended claims read on something that the original claims do not. Specifically, the newly amended claims read on materials, which contain a fibrous material, having an average fiber length of less than about 2 mm.

It is noted that the limitation that the fibrous material has an average fiber length of greater than about 2 mm was relied upon by the applicants in the original prosecution to distinguish over Tiefenbacher et al. See page 11, first full paragraph to page 13, line 3 of Paper No. 7 dated March 18, 1996 in U.S. Serial No. 08/327524, where it is argued that "[e]ach of independent claims 1, 23, 30 and 49 was originally drafted to include the limitation that the 'fibers hav[e] an average fiber length greater than about 2 mm'. In contrast, *Tiefenbacher et al.* teaches away from the use of fibers larger than 1.5 mm, as discussed hereinbelow. The ability to successfully mold a starch-bound article having fibers that have 'an average fiber length greater than about 2 mm' is made possible by the inclusion of pregelatinized starch component in significant quantities within the starch-based composition during the mixing process...This results in much more effective dispersion of the fibers, particularly 'fibers having an average fiber length greater than about 2 mm...[F]ibers having an average fiber length greater than about 2 mm' are an important component because they provide an important reinforcing function within the molded starch-bound articles...it is clear that *Tiefenbacher et al.* fails to teach or suggest the tremendous strengthening effect of the fibers, particularly well-dispersed fibers having an average length greater than about 2 mm."

### ***Response to Arguments***

4. For clarification purposes, it is noted that the phrase "the intermediate composition" in claims 32, 46, and 52 has been interpreted to mean "the aqueous starch-based composition".

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5. With regard to Applicant's arguments, applicants state that the courts in Hester Industries, Inc. v. Stein, Inc. (142 F.3d 1472, 1782-83 (Fed. Cir. 1988)) and Pannu v. Storz Instruments, Inc., (258 F.3d 1366 (Fed. Cir. 2001)) have held that there are exceptions to the recapture rule where reissue claims are materially narrowed in other respects. The examiner agrees that these courts have set forth exceptions, including a three-part test in Pannu where it must be determined whether the reissued claims were materially narrowed to avoid the recapture rule.

However, as set forth in Pannu, there can still be recapture even if the reissue claims are narrower in other respects. In Pannu, it was argued that because the reissued claims were materially narrowed in other respects, the reissue avoids the recapture rule. The fact scenario in Pannu, like the present case, involved a situation where the narrower aspects dealt with limitations unrelated to the limitation being surrendered. Specifically, in Pannu, the narrower limitations dealt with the positioning and dimensions of the snag resistant means, not the shape of the haptics. The court, in Pannu, held that the narrowing aspect of the claim on reissue was not related to the shape of the haptics, but rather the positioning and dimensions of the snag resistant means. Therefore, the reissued claims were not narrowed in any material respect compared with their broadening. Furthermore, "if the patentee is seeking to recover subject matter that had been surrendered during the initial prosecution this flexibility of analysis is eliminated, for the prosecution history establishes the substantiality of the change and stops its recapture." Anderson Int'l Eng'g & Mfg., Inc., 160 F.3d 1345, 1349, 48 USPQ2d 1631, 1634 (Fed. Cir. 1998); see also Mentor, 998 F.2d at 996, 27

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USPQ2d at 1525 (“[I]n this case, the reissue claims are broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution. Mentor thus attempted to reclaim what it earlier gave up.”). In prosecuting the original patent, Pannu specifically limited the shape of the haptics to a “continuous, substantially circular arc.” On reissue, he is stopped from attempting to recapture the precise limitation he added to overcome prior art rejections.

In the present case, it is the examiner’s position that the omission of limitation that the fibrous material has an average fiber length of greater than about 2 mm is improper recapture when using either the two-part test detailed in the MPEP (1412.02) or the three-part test set forth in Pannu. In the present case, the narrowing aspects do not deal with the fibrous material, but rather the coating material and process of forming the composite composition. Thus, the present claims are not narrowed in any material aspect compared with the broadening. Thus, following the binding and clear holdings by the Federal Circuit in Pannu, the applicants in the present case are stopped from attempting to recapture the limitation they argued to overcome the prior art rejections in the original prosecution.

6. Additionally, applicants suggest that the examiner has disregarded the rules set forth by the Federal Circuit and merely relied upon the Manual of Patent Examination Procedure (MPEP) with regard to the examination of the present application in view of the issue of recapture. The examiner agrees that the MPEP is, in fact, a “reference work on the practices and procedures relative to the prosecution of patent applications before the Patent and Trademark Office.” The examiner also agrees that the MPEP

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“does not have the force of law or the force of the rules in Title 37 of the Code of Federal Regulations” and that the MPEP establishes that “Examiners will be governed by the applicable statutes, rules, decisions, and orders and instructions issued by the Commissioner and the Assistant Commissioners.”

However, the MPEP also explains “It contains instructions to examiners, as well as other material in the nature of information and interpretation, and outlines the current procedures which the examiners are required and authorized to follow in appropriate cases in the normal examination of a patent application.” The MPEP was established as a guide which was created based on various binding decisions by the court. Evidence of this is found in the fact that the examiner relied on the Two-Step Test for Recapture set forth in MPEP 1412.02 which is based on Clement, (131 F.3d at 1468-69, 45 USPQ 2d at 1164), wherein the Court of Appeals for the Federal Circuit set forth guidance for recapture. Thus, it is the position of the examiner that the rules set forth by the Federal Circuit have in no way been disregarded during examination.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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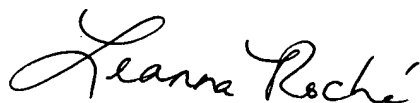
mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Contact Information**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leanna Roche whose telephone number is 703-308-6549. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm (with alternate Mondays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on 703-308-1261. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



lmr  
February 26, 2002



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